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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771
28875 7590 05/07/2007 Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
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			05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Janice A. Mooneyham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 16, 2007, wherein:

Claims 1-2, 4-13, 18-20 and 44-45 are currently pending;

Claims 1, 18, 19-20 and 44-45 have been amended.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 16, 2007 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on March 13, 2007 is being considered by the examiner. Furthermore, the Examiner asserts that all IDS properly submitted on the record have been considered. The Examiner is unable to find any record of the attached record that has a strike through as having been submitted in this application, thus it has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology ***in a first interface***, displaying first additional information associated with at least a portion of the patents of the set ***in a second interface separate from the first interface*** upon the selection of an icon ***positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second,***

displaying second additional information associated with at least one of the patents of the list ***in a third interface separate from the first interface and the second interface*** upon the selection of an additional icon ***positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface***

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has a step of displaying a notes filed for receiving manually entered notes followed by a step of storing the entered notes. However, applicant never actually positively recites a step of actually receiving the notes.

The applicant has a step of ***allowing the manual selection of a file.***

"Allowing" only requires making an action possible, not necessarily performing the action. Using terms like "allowing" or "permitting" an action, e.g. "allowing a user to select". Again, this is distinct from actually doing the action, e.g. selecting.

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing ***a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier.***

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus **associating** the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, **wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents**

What does the applicant mean by associating the file with the identifier?

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with? Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes? Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file?

The applicant has a step of **associating a plurality of patents with the at least one identifier**. Page 8 of the specification states that an identifier may include a patent

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number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

Thus, how can a plurality of patents be associated with one patent number?

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier. The applicant then adds the language "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible? It is not clear what applicant is claiming in this step.

The applicant then has added the language that "wherein a set of patents is *reported* by – what does the applicant mean by "reported"? What set of patents are being reported?

The applicant then states *displaying a technology mapping depicting one category of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology.*

First, applicant only claims one category of technology in the displaying of a technology mapping. Then the applicant claims displaying statistics in each category of technology. How can one category become each category? Where does the technology mapping come from?

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. **Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier** (it is not clear where the plurality of patents come from since there is no search being performed), **making the notes and files and patents accessible by selection of the at least one identifier** (however, where is it in the claim language that the notes, files and patents where ever correlated with one identifier). **Applicant then states that a set of patents is reported** (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), **displaying a technology mapping depicting at least one category of technology** (note that the patents are not mentioned in this displaying step), **displaying statistics**

regarding a number of patents of the set in each category (note that now we have more than one category, wherein the step above one requires one category),
displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology (note that now we are back to one category of technology and that the information includes a list of the patents of the set associated with this one category of technology, however there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent),
displaying second information associated with at least one of the patents in the list in a third interface (however, it is unclear where this list even comes from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail". This is unclear. What does the applicant mean by "made accessible?" Are they transmitted?

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

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In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

6. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant amended the invention from a method to a system but does not provide any structure to the system.

The Examiner finds that because claim(s) 1-2, 4-13, 18-20, and 44-45 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Barnett et al (2002/0082778) (hereinafter referred to as Barnett).

Referring to Claims 1, 18, 19, 20, 44 and 45

Rivette discloses a method, computer program product embodied on a computer readable medium and a system (page 9 [0289-0291] page 10 [0294]) for organizing patents utilizing a computer-implemented system, comprising:

computer code for performing the steps of the method [0012] [0289], comprising:
displaying (display unit (1122) page 9 [0292]) a notes field for receiving manually entered notes (Fig. 4 Notes Mode (414) (Figure 134 (13408) [1200-1202] [0255-0257] Figs. 125-143 [0314] [0384] [0326]);

storing the manually entered notes in association with at least one identifier (patent number) (Fig. 111; Figure 134 save button [0380-0387]);

allowing the manual selection of a file ([0373] [0383] Figure 134 (13404);

storing the manually selected file in association with the at least one identifier (patent number) by providing a correspondence between the file and the at least one identifier wherein a manually selected first file is capable of being associated with a first identifier (patent number) corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group (Figures 117-119 and Figures 133 and 134 (13304) Analog Special Effects; [0264] a group is a data structure that includes a collection of patents [0326-0329] [0330-0344] [0373-0379] [0393]) ; and

associating a plurality of patents with the at least one identifier (Figure 122; [0265]);

wherein the manually entered notes and the patents are accessible by subsequent selection of the at least one identified (Figures 117-120, 122, 133, 134, [1157-1162] [0373-0387] [0329])

wherein a set of patents is reported by;

displaying a mapping depicting at least one category of technology utilizing a graphical user interface (page 2 [0025], page 7 [0262-0268]; pages 8-9 [0277] [0848] Figure 18 [1101-1110]),

displaying statistics regarding a number of the patents of the set in each category of technology ([0025] [0262] [0266] [0277] Figure 102-105),

displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon (Figs. 148, 117-120, 122, 133, 134, 153 [0377] [1157-1162]),

wherein the first additional information includes a list of patents of the set associated with one category of technology ([0020], [0262, 0264-0268], [0331] [1027-1028]),

displaying additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from a group consisting of a patent number, status, an exemplary claim, and an exemplary figure ([0377], Fig. 7, Fig. 45 (4512), Figs. 111-112; Figure 148; [1157-1162]),

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface (Figs. 111-112);.

wherein said method is at least in part carried out utilizing the computer implemented system (Fig. 3-4); and wherein the method supports a drill down technique ([0270]).

Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs. 57, 125, 117). Rivette discloses technology and competitor analysis [0262—0268]. However, Rivette does not explicitly disclose displaying a technology mapping (although page 2 [0025] does not exclude technology mapping) depicting at least one category of technology or wherein the first additional information includes a list of patents of the set associated with one category of technology, or wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.

However, Barnett disclose depicting at least one category of technology and the first additional information includes a list of patents of the set associated with one category of technology, and wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed (Figures 21-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the patent method and system of Rivette the technology mapping disclosed in Barnett to aid in strategic and tactical business decisions.

Moreover, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known. Furthermore, because of the way this step is worded, it could encompass a person e-mailing another person to come look at the notes and files.

E-mail, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be attaching a file and emailing it to another computer or simply having a

hyperlink in the email. Industry has utilized computers for years as a way of tracking and documenting information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication since it is fast and efficient and reliable way of communication.

Referring to Claims 2, 4-6:

Rivette discloses a method wherein the at least one identifier is determined by selecting an already existing identifier (Figure 147 and 117-120, 133-134).

It is old and well known to have a method wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu. For example, while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search.

It is also old and well known to add a file and thus create a new file with a new identifier or modify the name to a file thus creating a new identifier.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a pull-down menu, an add icon or a modify icon to the disclosure of Rivette so as to allow for easy access to the identifiers.

Referring to Claims 7-11:

Rivette discloses wherein a notes field allows a user to cut and paste notes (Fig. 58, Fig. 137 (Note ToolBar (13706))), wherein the file is selected utilizing a file structure field (Fig. 58), wherein the file structure field includes a file tree structure (Fig. 58), wherein the file structure field allows a user to browse various folders where files have been previously stored, Fig. 58), and wherein the file structure is displayed

simultaneously with the notes filed on the same interface (Fig. 58 Figures 117-120, 133-134, [1157-1162], [1193].

Referring to Claim 12:

Rivette discloses wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers (Fig. 6, Figs. 12B-12L, Figure 148).

Referring to Claim 13:

Rivette discloses wherein the database is a comprehensive database of all patents issued by at least one government agency (Document database [0310-0311], Patent bibliographic database [0318-0322] [0806-0807] [0418-0422] [0388-0417])

Response to Arguments

8. Applicant's arguments filed August 24, 2006 have been fully considered but they are not persuasive.

The Examiner has maintained the rejection under 35 USC 112, second paragraph. The amendments to the claims only include computer code language and do not further clarify the limitations.

The Examiner directs the applicant to the discussion in the rejection as to any other arguments. The Examiner has tried to address the arguments in the body of the rejection.

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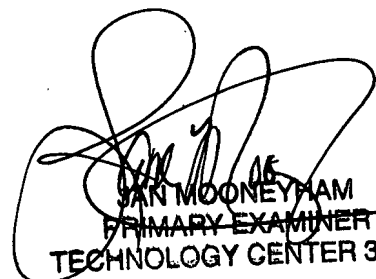
The Examiner asserts that the prima facie case of obviousness has been met.

The knowledge is available to one of ordinary skill in the art and thus, there is a reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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